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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,783	01/24/2000	Richard C. Johnson	ORCL5628	7640

22430 7590 06/10/2003

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EXAMINER

KAPADIA, MILAN S

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/490,783

Applicant(s)

JOHNSON, RICHARD C.

Examiner

Milan S Kapadia

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3626

**DETAILED ACTION**

*Notice to Applicant*

1. This communication is in response to the amendment filed 16 April 2003. Claims 1-28 are pending. Claims 18 and 27 have been amended.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 7-11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiden et al. (6,055,520).

(A) Claims 1, 2, 4, 5, 7-11, and 13-16 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

4. Claims 3, 6, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiden et al. (6,055,520 as applied to claims 1, 7, and 13 above and further in view of Shkedy (6,260,024).

(A) Claims 3, 6, 12, and 17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

5. Claims 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy et al. (6,260,024) in view of Heiden et al. (6,055,520).

As per claim 18, Shkedy teaches a method of enabling a customer to anonymously purchase an item from a vendor via an electronic draft for delivery to an address comprising the steps of:

storing, in a bank, an encrypted unique identifier for the customer, the encrypted unique identifier being linked to the customer's personal and financial information stored in the bank, including the delivery address (Shkedy; col. 10, lines 1-10 and col. 21, lines 24-44, and col. 25, lines 31-61);

authenticating the customer having caused a draft to be executed for payment of at least one of a purchase price of the item and a shipping cost by encrypting at least a portion of an identification data provided by the customer and successfully matching the encrypted identification data with the stored encrypted unique identifier (Shkedy; col. 21, lines 25-44);

retrieving at least the authenticated customer's financial information (Shkedy; col. 5, line 61-col. 6, line 3);

Art Unit: 3626

honoring a draft presented by the vendor for payment of the item only when the customer is successfully authenticated by the bank (Shkedy; col. 6, lines 29-39);

Shkedy fails to expressly teach retrieving at least the authenticated customer's delivery address, generating a package code for the item, the generated package code being devoid of delivery address information, associating the retrieved delivery address to the generated package code, sending the package code to the vendor, the vendor affixing the package code to the package, and whereby the shipper picks up the item from the vendor, and prints out a shipping label for the package, a delivery address on the label being that customer address linked to a package code stored in the shipper database that matches the package code affixed to the package. However, this feature is old and well known in the art, as evidenced by Heiden's teachings with regards to retrieving at least the authenticated customer's delivery address (Heiden; col. 6, lines 35-58), generating a package code for the item, the generated package code being devoid of delivery address information, associating the retrieved delivery address to the generated package code (Heiden; col. 7, lines 1-24), sending the package code to the vendor, the vendor affixing the package code to the package (Heiden; col. 7, lines 16-24), and whereby the shipper picks up the item from the vendor, and prints out a shipping label for the package, a delivery address on the label being that customer address linked to a package code stored in the shipper database that matches the package code affixed to the package (Heiden; col. 6, lines 35-67). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy with Heiden's

Art Unit: 3626

teaching with regards to these limitations, with the motivation of producing package labels without disclosing the delivery address to the party producing the package (Heiden; col. 1, lines 44-48).

Shkedy and Heiden collectively fail to expressly teaching sending the package code and associated delivery address to a shipper for storage in a shipper database. However since the combined system of Shkedy and Heiden clearly teach a shipper sending a package having an associated package code and delivery address (Heiden; col. 6, lines 59-67) and a database containing package codes and delivery addresses (Shkedy; col. 10, lines 1-10, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy and Heiden to send the package code and associated delivery address to a shipper for storage in a shipper database, with the motivation of providing the delivery address of where the package should be sent to the shipper.

Claims 19-26 and 28 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

Claim 27 differs from claim 18 by reciting the associated delivery address as an electronic address, the product comes in a digital form, and the vendor forwarding the goods to a different electronic address. As per these limitations, Shkedy teaches an embodiment of his system can be used with electronic email addresses and used to

Art Unit: 3626

exchange digital files, graphics, video, and audio (Shkedy; col. 10, line 54-col. 11, line 7).

### ***Response to Arguments***

6. Applicant's arguments with respect to amended claims 18, and 27 have been considered but are moot in view of the new ground(s) of rejection.

(A) At page 7 of the 4/16/03 communication, Applicant argues each of the applied references individually. In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the teachings that Applicant argues are missing from the Shkedy reference are clearly disclosed in the respective teachings of Heiden when considered collectively with that of Shkedy, as discussed in detail within a prior Office Action (paper number 5) and in the preceding rejections, and incorporated herein.

Further, the features newly added and entered in the amendment filed 4/16/03, have been shown to be fully disclosed by or obvious in view of the collective teachings of Shkedy, and/or Heiden, as discussed above in detail within the preceding sections of the present Office Action.

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. Applicant's arguments filed 4/16/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 4/16/03.

(A) At pages 5-7 of the 4/16/03 response, Applicant argues that "...the indicia 10" of Heiden "contain the delivery address information, albeit not in human readable form" in reference to claims 1, 7, 13, 18, and 27. In response, it is respectfully submitted, that the full teachings of Heiden have not been considered. Heiden teaches, as cited in Applicant's response on page 5, that for lists of greater value, the delivery information can be a pointer to an address database accessed by the Postal Service. As such, it is respectfully submitted, that if the indicia only contain pointers to an address database accessed by the Postal Service, then the indicia is devoid of delivery address information.

As per the remaining arguments, the Examiner is concerned that, aside from merely alleging that certain claimed features are not obvious from Heiden and/or



Art Unit: 3626

Shkedy essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977). In the instant case, Applicant states that certain features are not taught by the applied are (i.e., steps of receiving a request to pick up a package from the vendor that is identified by a package code devoid of delivery address information, request to pick up the package includes an associated shipping identifier and a delivery address..., etc). The Examiner holds that the cited features are taught by the applied prior art as shown above and in the previous Office Action. The Examiner is unclear exactly what Applicant believes is not taught by the prior art. The Examiner assumes that Applicant is arguing the package code being devoid of address information. As such, the Examiner respectfully notes the above response to the prior arguments and that response is incorporated herein.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

Application/Control Number: 09/490,783

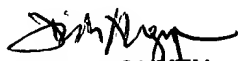
Page 10

Art Unit: 3626

305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mk

  
DINH X. NGUYEN  
PRIMARY EXAMINER

June 5, 2003